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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,728	11/06/2001	Mohammad A. Abdallah	42390P5943C	2359

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EXAMINER

ELLIS, RICHARD L

ART UNIT PAPER NUMBER

2183

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SA

Advisory Action

Application No.

10/005,728

Applicant(s)

ABDALLAH ET AL.

Examiner

Richard Ellis

Art Unit

2183

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.Claim(s) objected to: None.Claim(s) rejected: 16-44.

Claim(s) withdrawn from consideration: _____.

8. ☒ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

10. ☒ Other: See Continuation Sheet


RICHARD L. ELLIS
PRIMARY EXAMINER

Continuation of 3. Applicant's reply has overcome the following rejection(s): 112 2nd paragraph rejection of claims 21 and 33. Applicant's explicit statement that there is no typographical error and that the claims are written exactly as applicant intended that they be written is sufficient to overcome the rejection.

Continuation of 5. does NOT place the application in condition for allowance because: Applicant is attempting to continue prosecution of the application after prosecution on the merits has closed. Among the arguments presented applicant again argues the 35 USC 112 rejection of claims 17, 21-24, and 26-38 as being indefinite for use of a trademark as a claim limitation. By applicant's own admission in the argument, the use of the trademark "PENTIUM" in the claims is improper. Applicant states: "Applicant respectfully submits that the trademark, PENTIUM, is not being used as descriptive of a material or product. Rather what is set forth is, the "PENTIUM microprocessor instruction set," which is descriptive of the source of a microprocessor instruction set." Applicant admits in the arguments that the trademark PENTIUM is being used to identify a "SOURCE" of the instruction set, which is exactly the very reason why use of a Trademark renders a claim indefinite. By only identifying a "SOURCE" of the instruction set, the use of a trademark in a claim does not limit the claim to any specific instruction set, which is the very basis for rejection of the claim as indefinite, because the boundaries of the claim can not be determined with specificity, because the claim does not indicate where that boundary will lie.

Continuation of 10. Other: Applicant is reminded of the provisions of MPEP § 714.12 which states in pertinent part the following:

Once a final rejection that is not premature has been entered in an application, applicant or patent owner no longer has any right to unrestricted further prosecution.

The prosecution of an application before the examiner should ordinarily be concluded with the final action.

Applicant is additionally reminded of MPEP § 714.13 which states in pertinent part the following:

ENTRY NOT A MATTER OF RIGHT

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims.

Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(c) is expected in all amendments after final rejection.

Further examination of the application may be obtained by filing a continued prosecution application (CPA) under 37 CFR 1.53(d), if appropriate. See MPEP § 201.06(d). CPA practice does not apply to utility or plant applications if the prior application has a filing date on or after May 29, 2000. See MPEP § 706.07(h), paragraphs I and IV.